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| Notice of Allowability | Application No. | Applicant(s) | |
| | 09/867,753 | WEISS ET AL. | |
| | Examiner | Art Unit | |
| | Robert B Mondesi | 1653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to February 26, 2004.
2. ☒ The allowed claim(s) is/are 18-21, 23 and 24.
3. ☒ The drawings filed on 31 May 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____ 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____ 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____ |
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EXAMINER'S AMENDMENT

Claims 18-21 and 23-24 directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims **3-13 and 16-17**, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, made in Office action mailed on June 25, 2003 is now subject to being rejoined. Process claims **3-13 and 16-17** hereby rejoined and fully examined for patentability under 37 CFR 1.104. **Claims 2, 15 and 22** not directed to the process of making or using the patentable product, will not be rejoined.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Richard Lebovitz on July 16, 2004.

The application has been amended as follows:

In the specification page 13 lines 4 and 5:

Sense 5'-ATGGCGCGTTTCGCTCGTCCACGAC-3' (SEQ ID NO: 5)

Antisense 5'-TAGTCCACGACGATGTAGACACAG-3' (SEQ ID NO: 5)

In the specification page 13 lines 8 and 9:

Sense primer 5'-CTAGAAGCATTTGCGGTGGACGATGGAGGG-3' (SEQ ID NO: 6)

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Antisense primer 5'-CTAGAAGCATTGCGGTGGACGATGGAGGG-3' (SEQ ID NO: 6)

The following claims were cancelled:

2. (Cancelled) (pertaining to nonelected product).
3. (Cancelled)
4. (Cancelled)
5. (Cancelled)
6. (Cancelled)
7. (Cancelled)
8. (Cancelled)
9. (Cancelled)
10. (Cancelled)
11. (Cancelled)
12. (Cancelled)
13. (Cancelled)
15. (Cancelled) (pertaining to nonelected product).
16. (Cancelled)
17. (Cancelled)
22. (Cancelled) (pertaining to nonelected product).

The following claim was amended:

21. (presently amended) An isolated polynucleotide for a human PEM, comprising
(a) a polynucleotide sequence continuously coding for a polypeptide having the amino

acid sequence set forth in SEQ ID NO:2, [or a fragment thereof] which is specific for human PEM; (b) a polynucleotide sequence as set forth in SEQ ID NO:1 [or a fragment thereof] which is specific for human PEM; or complements thereto.

Reasons for allowance

The following is an examiner's statement of reasons for allowance: With regards to "PEM" the applicants have stated on the record in the Remarks filed February 26, 2004, that "the term "PEM" is used through out the specification to refer to polynucleotides and polypeptides having the disclosed properties and it does not appear to have been described in the specification as an acronym or abbreviation".


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert B. Mondesi
Patent Examiner
Group 1653
07-22-04


ROBERT A. WAX
PRIMARY EXAMINER